

Remarks

1. **Introduction.** This is in response to the Office Action mailed November 1, 2005 on behalf of Examiner Inder Mehra. The following sections are numbered in accordance with the corresponding paragraph numbers in the Office Action.

Preliminary Amendment of March 6, 2002. A Preliminary Amendment was filed with the application. It does not appear on the PAIR "File History" listing of contents, however, the Preliminary Amendment is indeed in the record and can be found in the Image File Wrapper on PAIR.

Accordingly, claims 1-41 are not pending as indicated in the Office Action Summary. Rather, claims 1-19 and 31-41 should have been **canceled** by the March 6, 2002 Preliminary Amendment.¹ It is believed that claims 20-30 in fact are pending for examination. This is reflected in the Listing of All Claims set forth above. No new amendments to the claims are submitted in this response.

Specification

2. The Examiner states that the four listed provisional applications filed in 1997 are not mentioned in the specification. However, specific references to these applications were added to the specification by the Preliminary Amendment, filed March 6, 2002 (with the instant application). That Preliminary Amendment can be found in PAIR IFW and it includes the following:

"In the Specification:

Replace the first paragraph of the specification (page 1, lines 14-16) with the following paragraph:

--This application is a divisional of U.S. Application No. 09/531,367 filed March 21, 2000, which is a CIP of U.S. Application No. 09/230,079, filed May 13, 1999, now U.S. Pat. No. 6,144,336, issued November 7, 2000, which is the U.S. national phase application corresponding to

¹ A Second Preliminary Amendment, filed August 30, 2002 amended the title to read: **A CELLULAR TELEPHONE HAVING IMPROVED IN-BAND SIGNALING FOR DATA COMMUNICATIONS OVER DIGITAL WIRELESS TELECOMMUNICATIONS NETWORKS.**

International Application No. PCT/US98/10317, filed May 19, 1998, and claiming priority from U.S. Provisional Patent Application Nos. 60/047,034 filed on May 19, 1997; 60/047,140 filed on May 20, 1997; 60/048,369 filed on June 3, 1997; 60/048,385 filed on June 3, 1997; and 60/055,497 filed on August 12, 1997.—“ [Preliminary Amendment, March 6, 2002.]

Numerous minor corrections to the Specification were made in the same amendment. They should be properly entered into the record. Revised Drawing Figures 7 and 9 were submitted as well. To the extent that the Preliminary Amendment and/ or the Second Preliminary Amendment were not entered, Applicant would respectfully request that they now be entered, *nunc pro tunc*.

Priority

3. This section of the Office action is not understood and consequently Applicant respectfully requests clarification. For example, the Examiner refers to 35 U.S.C. [1]; the relevance of which is not apparent here. Applicant believes that the requirements for a claim of priority under 35 U.S.C. §119(e) and §120 have been met. The Preliminary Amendment amended the specification to contain the specific references to the prior applications as required by statute. The following table shows that at least one inventor, namely Dan A. Preston, is common to -- first, the five provisional applications filed in 1997 and listed below; second, Application No. 09/230,079 (Attorney matter 4:1) (now U.S. Pat. No. 6,144,336), which is the national phase of a PCT application that claims priority from the five provisional applications; and third, Application No. 09/531,367 (Attorney matter 4:7), which is the parent application as to which the present application is a divisional.

Inventorship Table

| | | Dan PRESTON | Joseph PRESTON | Robert LEYENDECKER | Wayne EATHERLY | Rod L. PROCTOR |
|--------------------------------------|------|-------------------------------------|-------------------------------------|-------------------------------------|-------------------------------------|-------------------------------------|
| present application 10/092,661 | 4:10 | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> |
| divisional of 09/531,367 | 4:7 | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> |

| | | | | | | |
|--|--|-------------------------------------|-------------------------------------|-------------------|--|--|
| CIP of 09/230,079 | 4:1 ² | <input checked="" type="checkbox"/> | <input checked="" type="checkbox"/> | also JAMES VROMAN | | |
| 60/047,034 filed May 19, 1997; | <input checked="" type="checkbox"/> sole | | | | | |
| 60/047,140 filed on May 20, 1997 | <input checked="" type="checkbox"/> sole | | | | | |
| 60/048,369 filed on June 3, 1997; | <input checked="" type="checkbox"/> sole | | | | | |
| 60/048,385 filed on June 3, 1997 | <input checked="" type="checkbox"/> sole | | | | | |
| 60/055,497 filed on August 12, 1997. | <input checked="" type="checkbox"/> | | JAMES VROMAN | | | |

The Examiner cites to "35 U.S.C. [1]" which appears to be an error. The Examiner states: "Claims, which are supported by individual priority applications be identified with reference to the individual applications." This is not believed to be required to assert a priority claim. For these reasons, Applicant respectfully traverses the objection/ requirement with regard to the priority claims and requests reconsideration and clarification.

Information Disclosure Statement

4. The IDS filed 9/4/02 apparently lacked copies of foreign documents and other documents as pointed out by the Examiner. Those documents are included in a new IDS mailed January 17, 2006. (PAIR shows that this new IDS has been received in the PTO.)
5. Applicant notes the Examiner's acknowledgement that the IDS's dated 9/16/05 and 9/18/02 have been considered.

Double Patenting

See paragraphs 6 and 7. The Examiner asserts a statutory type double patenting rejection under Section 101. Specifically, this is a *provisional rejection* of claims 1-41 as being the same as claims 1-41 of copending application no. 10/095,866 filed March 11, 2002.

² Attorney Docket 4:1 corresponds to Application No. 09/230,079, filed as application No. PCT/US98/10317 on May 19, 1998 (claiming priority from the five provisional applications listed), now U.S. Pat. No. 6,144,336.

(Attorney docket 4:11). Applicant respectfully traverses the provisional rejection and requests that it be withdrawn for the following reasons.

First, it is noted that Application No. 10/095,866 is a divisional of Application No. 09/531,367 as is the present application. In other words, both this case and Application No. 10/095,866 are children of Application No. 09/531,367 (Now U.S. Pat. No. 6,690,681.)

The parent case earlier had 41 claims. As noted above, the present application was amended (by Preliminary Amendment at the time of filing) to cancel claims 1-19 and 31-41, thus presenting claims 20-30 for examination.

Application No. 10/095,866 (Attorney docket 4:11) also began with 41 claims from the parent. However, in that case, a Preliminary Amendment was filed with the application on March 11, 2002. That preliminary amendment canceled claims 1-36 and 40-41. Accordingly, in that case, only claims 37-39 are pending for examination.

In sum, there is no double patenting in the claims of these two applications.

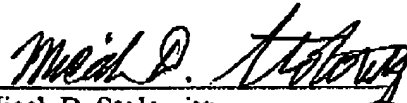
Other Related Applications

For the convenience of the Examiner, Applicant would point out the following four divisional applications which are pending or issued (including this one); all are divisionals of Application No. 09/531,367:

| Attorney Docket | Application Number | Filed | Claims after P.A. | Status | |
|-----------------|--------------------|-----------|-------------------|-----------------------|-----------|
| 4:9 | 09/625,149 | | | Patented US 6,681,121 | 1/20/2004 |
| 4:10 | 10/092,661 | 3/6/2002 | 20-30 | pending | |
| 4:11 | 10/095,866 | 3/11/2002 | 37-39 | pending | |
| 4:12 | 10/099,098 | 3/15/02 | 40-41 | pending | |

The application should now be in condition for allowance. Please contact the undersigned if any issues remain.

Respectfully submitted,
Airbiquity, Inc.

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Attorney Docket No. 44375/4:10